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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,739	08/07/2001	Shigehiro Miyashita	Q65752	9599

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SUGHRUE, MION, ZINN
MACPEAK & SEAS
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Washington, DC 20037

EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 01/30/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,739

Applicant(s)

MIYASHITA, SHIGEHIO

Examiner

Md S Elahee

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 03 & 04 . 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-10, 12-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (International Pub. No. GB 2251357) and in view of Takayasu (International Pub. No. JP 11017770).

Regarding claim 1, Fujii teaches a storage unit which stores subscriber information (i.e., a replica of directory data of records), each of which includes data of a subscriber (i.e., counter communication end) (abstract; fig.4; page 8, lines 26, 27, page 9, lines 1-9).

However, Fujii fails to teach "a communication control unit which refers to said directory data replica to determine whether or not a connection of a communication request from said counter communication end to a mobile phone is permitted, in response to a connection confirmation request which is generated in response to said communication request, and transmits a response indicative permission or non-permission of the connection of said communication request to said mobile phone". Takayasu teaches a communication control unit which refers to the directory data replica to determine whether or not a link (i.e., connection) of a communication request from the opposite party (i.e., counter communication end) to a communication device (i.e., mobile phone) is permitted, in response to a link confirmation request which is generated in response to the communication request, and transmits a response

Art Unit: 2645

indicative permission or non-permission of the connection of the communication request to the communication device (abstract; page 1, paragraphs 0008, 0009). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fujii to allow a communication control unit which refers to the directory data replica to determine whether or not a connection of a communication request from the counter communication end to a mobile phone is permitted, in response to a connection confirmation request which is generated in response to the communication request, and transmits a response indicative permission or non-permission of the connection of the communication request to the mobile phone as taught by Takayasu. The motivation for the modification is to have doing so in order to establish a communication link between two parties.

Regarding claim 2, Fujii teaches a storage unit which stores said directory data of records, each of which contains at least one of a name, phone number and address (i.e., e-mail address) of the counter communication end (abstract; fig.4; page 8, lines 26, 27, page 9, lines 1-9).

Fujii further teaches an operation section which generates a recalling instruction (i.e., upload instruction) in response to an operation by a user of the mobile phone (abstract; fig.17; page 12, lines 1-19).

Fujii further teaches a transmitting section which transmits the subscriber information (i.e., directory data) to the external device (i.e., directory server) in response to the upload instruction such that the subscriber information is stored as a part of the subscriber information replica in the external device (fig.17; page 12, lines 1-19, page 13, lines 9-13).

Art Unit: 2645

Regarding claims 3, 9, 13 and 18, Fujii teaches a keypad (i.e., editing section) which edits subscriber information (i.e., the group of records of the directory data) in response to an operation by the user, and sets the edit flag (page 12, lines 1-19).

Fujii further teaches a transmitting section which transmits the subscriber information (i.e., the records of the groups with the set edit flags of the directory data) to the external device (i.e., directory server) in response to the recalling instruction (i.e., upload instruction) such that the subscriber information is stored as the part of the subscriber information replica in the external device (fig. 17; page 12, lines 1-19, page 13, lines 9-13).

However, Fujii fails to teach "edit flag". Takayasu teaches flag pattern (i.e., edit flag) (page 1, paragraph 0003). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fujii to allow edit flag as taught by Takayasu. The motivation for the modification is to have doing so in order to transmit the connect frame.

Regarding claims 4, 10, 14 and 19, Fujii teaches that the number of records in each group is inherently one (page 8, lines 26, 27, page 9, lines 1-3).

Regarding claims 5, 15 and 17 are rejected for the same reasons as discussed above with respect to claims 1-3.

Regarding claim 6, Fujii teaches communication request is a phone call, and each of the records includes said phone number of said counter communication end and further includes a non-permission flag set when said mobile phone should not be connected to said counter communication end and reset when said mobile phone should be connected to said counter communication end (page 12, lines 1-19).

Fujii further teaches a switching apparatus which generates said connection confirmation request to said directory server in response to said phone call, and connects said phone call to said mobile phone when receiving the permission response, and discards said phone call to said mobile phone when receiving the non-permission response (fig.17; page 12, lines 1-19, page 13, lines 9-13).

However, Fujii fails to teach "determine whether said non-permission flag corresponding to said phone number of said counter communication end is set or reset, transmits said permission response to said switching apparatus when said non-permission flag is reset, and transmits said non-permission response to said switching apparatus when said non-permission flag is set". Takayasu teaches determining whether the FLG pattern (i.e., non-permission flag) corresponding to the phone number of the other party (i.e., counter communication end) is detected or not detected (i.e., set or reset), transmitting the permission response to the switching apparatus when the FLG pattern is not detected (i.e., reset), and transmitting the non-permission response to the switching apparatus when the FLG pattern is detected (i.e., set) (page 1, paragraph 0003, page 2, paragraphs 0018, 0019). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fujii to allow determining whether the non-permission flag corresponding to the phone number of the counter communication end is set or reset, transmits the permission response to the switching apparatus when the non-permission flag is reset, and transmits the non-permission response to the switching apparatus when the non-permission flag is set as taught by Takayasu. The motivation for the modification is to have doing so in order to transmit the connect frame or request frame reception check.

Art Unit: 2645

Regarding claims 8 and 12 are rejected for the same reasons as discussed above with respect to claims 1 and 2.

Regarding claim 16 is rejected for the same reasons as discussed above with respect to claim 1.

Regarding claim 21 is rejected for the same reasons as discussed above with respect to claim 6. Furthermore, Fujii fails to teach "discarding said phone call to said mobile phone in response to said non-permission response". Takayasu teaches inherently discarding the phone call to the mobile phone in response to the non-permission response (page 3, paragraph 0020). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fujii to allow discarding the phone call to the mobile phone in response to the non-permission response as taught by Takayasu. The motivation for the modification is to have doing so in order to request frame reception check.

3. Claims 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (International Pub. No. GB 2251357) and in view of Takayasu (International Pub. No. JP 11017770) and further in view of Fernandez et al. (International Pub. No. WO 99/65256).

Regarding claim 7 is rejected for the same reasons as discussed above with respect to claim 6. Furthermore, Fujii in view of Takayasu fails to teach that a mail server delivers said e-mail to said mobile phone. Fernandez teaches that a e-mail forwarding system (i.e., mail server) delivers the e-mail to the mobile phone (abstract; page 5, lines 21-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fujii in view of Takayasu to allow a mail server delivering the e-mail to the mobile phone as taught by

Art Unit: 2645

Fernandez. The motivation for the modification is to have doing so in order to answer the inbound call as well as make outbound call to the user.

Regarding claim 22 is rejected for the same reasons as discussed above with respect to claims 7 and 21.

4. Claim 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (International Pub. No. GB 2251357) and in view of Takayasu (International Pub. No. JP 11017770) and further in view of Beach (U.S. Pub. No. 2001/0055283).

Regarding claim 11 is rejected for the same reasons as discussed above with respect to claim 5. Furthermore, Fujii in view of Takayasu fails to teach "operation section generates a download instruction in response to an operation by a user of said mobile phone, and said transmitting section transmits said download instruction to said external unit". Evans teaches that the operation section generates a download instruction in response to an operation by a user of the mobile phone, and the transmitting section transmits the download instruction to the external unit (abstract; fig.4; page 2, paragraph 0023). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fujii in view of Takayasu to allow the operation section generating a download instruction in response to an operation by a user of the mobile phone, and the transmitting section transmits the download instruction to the external unit as taught by Evans. The motivation for the modification is to have doing so in order to send and receive messages using radio module.

Regarding claim 20 is rejected for the same reasons as discussed above with respect to claim 11. Furthermore, Fujii teaches inherently holding a part of the subscriber information (i.e.,

Art Unit: 2645

directory data) replica of records as the subscriber information (page 8, lines 26, 27, page 9, lines 1-3).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

M. E.

MD SHAFIUL ALAM ELAHEE
January 25, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
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